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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,911	11/14/2001	J. Aaron Bly	65678-0042	4207

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EXAMINER	
HEWITT II, CALVIN L	

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/990,911	BLY ET AL.
	Examiner	Art Unit
	Calvin L Hewitt II	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Status of Claims

1. Claims 1-23 have been examined.

Response to Arguments

2. In order for a sequence of operational steps to be considered a statutory process within 35 U.S.C. 101 the process has to be within the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of "useful arts" (*In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970)). The claims as they are written cannot promote the progress of science and the useful arts as the claims are implemented without a specific use of a computer technology (Note: a notebook such as an accountant's ledger is a "database configured to store information on a plurality of assets"). Claims 12, 17 and 22, are directed to an "electronic" system with a "manual check". A "manual" action is not part of the system. Therefore, it is not clear the scope of Applicant's invention.

Regarding the teachings of the prior art, Applicant is of the opinion that Johnson et al. and Geller et al. do not recite singly or in combination, "disposition of assets", "analyzing information associated with assets", "pre-defined

conditions" and/or "hierarchy of disposition options". The Examiner respectively disagrees. Johnson et al. teach a system for disposing assets (e.g. cars) where, given user and asset information, the system provides a customer with an optimal purchasing solution (column 16, lines 8-39). Specifically, Johnson et al. teach presenting to a customer various financing and leasing options (e.g. disposition options) based on data (e.g. pre-defined conditions) stored in customer, quotation, product, configuration and finance modules such as product, customer, and other financing data ('525, column 9, lines 46-54; column/line 11/64-12/12; column 12, lines 22-57; column 13, lines 5-23 and 35-51; column 14, lines 22-55; column 15, lines 17-40). To those of ordinary skill in asset financing, an option-to-buy lease is well known ('525, column 15, lines 17-40). In an "option-to-buy" arrangement a customer has the opportunity to purchase an asset that he/she was leasing at the end of the lease term (e.g. pre-defined conditions). At the time "to-buy" the Johnson et al. system can again be used to present purchase alternatives (e.g. another set of disposition options) a customer ('525, column 15, lines 17-40). Regarding the combination of Johnson et al. and Geller et al., Johnson et al. do not specifically recite ranking said options. Geller et al. teach a method and system for ranking alternatives based on customer specifications ('990, column 2, lines 30-35). Hence, it would have been obvious to use rankings as a way of effectively presenting options to a customer ('525, column 16, lines 20-23).

The following assertions of facts have gone unchallenged by the Appellant and are now considered prior art:

- option-to-buy, lease renewal, asset return, leasing of other assets, lease documents, lease term, asset usage as defined by lease agreement, maintenance history, etc.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The Applicant's claimed invention does not fall within the technological arts because no form of technology is disclosed or claimed. Claims 1, 17, and 21 use the term "database". However, in the context of the Applicant's claims a database can be a notebook, or even a piece of paper. Hence, the claimed invention does not promote the progress of science and the useful arts.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12, 17 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12, 17 and 22 are dedicated to a system, however they recite limitations that occur outside the system, in particular a "manual check".

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al., U.S. Patent No. 6,067,525.

As per claims 1-23, Johnson et al. teach a system for disposing products comprising: an asset database (figures 4, 10A, B, 12 and 14-15B), a set of pre-

defined conditions related to a recommendation of asset disposition based on information (associated with a plurality of assets) stored in said system (figures 10A-B; column/line 13/65-16/39), and providing disposition options (figures 21A-B; column/line 15/1-16/39). Johnson et al. provide a general teaching for developing a user-specific financing solution (e.g. leasing option) based on a desired asset and user specifications (figures 10A-B, 14-16, 21A-B; column/line 13/64-14/58, column/line 15/4-16/39). The terms such as option-to-buy, lease renewal, asset return, leasing of other assets, lease documents, lease term, asset usage as defined by lease agreement, maintenance history, etc. are well known to those of ordinary skill in providing assets for sale, rent and/or lease, and hence it would have been obvious to one of ordinary skill to incorporate said terminology when seeking to provide user's with various leasing options (column 15, lines 50-56). Johnson et al. also teach asset delivery (figure 21E; column/line 17/58-18/36). Specifically, the system of Johnson et al. is dedicated to providing users with various financing and leasing options based on data stored in customer, quotation, product, configuration and finance modules such as product, user, and other financing data (column 9, lines 46-54; column/line 11/64-12/12; column 12, lines 22-57; column 13, lines 5-23 and 35-51; column 14, lines 22-55; column 15, lines 17-40). However, according to the Applicant's system this data (e.g. asset return, make/model, etc.) is non-functional data as descriptive material cannot render nonobvious an invention that would have

otherwise been obvious (*In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)). The MPEP (2106 section V, B, 2) states that a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer). Claims 12, 17 and 22 recite additional non-functional data as they refer to steps/process/features that occur outside the system (i.e. a manual check). However, Johnson et al. do not provide a hierarchy of options. Geller et al. teach a ranking system that allows a user to rank products based on user specifications and to adjust said specifications to further analyze said products (abstract). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Johnson et al., and Geller et al. in order to effectively to present disposition options to a user ('525, column 16, lines 20-40; '990, abstract)

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

December 13, 2004